

Docket No.: 2839-0072-0 PCT

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/445,423  
Applicants: Kazuo HATA et al  
Filing Date: December 10, 1999  
For: CERAMIC SHEET AND METHOD OF  
PRODUCING CERAMIC SHEET  
Group Art Unit: 1774  
Examiner: L. Ferguson

ATTORNEYS AT LAW

NORMAN F. OBLON  
(703) 413-3000  
NOBLON@OBLON.COM

KIRSTEN A. GRÜNEBERG, Ph.D.  
REGISTERED PATENT AGENT  
(703) 413-3000  
KGRUNEBERG@OBLON.COM

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SIR:


Attached hereto for filing are the following papers:

**RESPONSE TO RESTRICTION REQUIREMENT**

Our check in the amount of \$-0- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
Norman F. Oblon  
Attorney of Record  
Registration No. 24,618

Kirsten A. Grueneberg, Ph.D.  
Registration No. 47,297



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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

IN RE APPLICATION OF:

Kazuo HATA, et al.

SERIAL NO.: 09/445,423

FILED: December 10, 1999

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: GROUP ART UNIT: 1774

: EXAMINER: L. FERGUSON

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FOR: CERAMIC SHEET AND METHOD OF PRODUCING CERAMIC SHEET

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**RESPONSE TO RESTRICTION REQUIREMENT**

ASSISTANT COMMISSIONER FOR PATENTS  
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SIR:

Responsive to the Official Action dated March 23, 2001, Applicants elect, with traverse, Group I, Claims 1-4 and 9-10, for further prosecution.

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**REMARKS**

The Office has required restriction in the present application as follows:

Group I: Claims 1-4 and 9-10, drawn to an article in the form of a ceramic sheet;  
and

Group II: Claims 5-8, drawn to a method of making a ceramic sheet.

Applicants elect, with traverse, Group I, Claims 1-4 and 9-10, for further prosecution.

The Examiner, citing PCT Rule 13.1, contends that Groups I-II do not relate to a single general inventive concept. Specifically, the Office argues that the application lacks unity of invention.

The Applicants respectfully traverse the Restriction Requirement on the ground that unity of invention does exist between Groups I-II because there is a technical relationship

that involves the same special technical feature. It is this technical feature that defines the contribution which each of the Groups, taken as a whole, makes over the prior art.

Applicants further traverse the Restriction Requirement on the ground that the Office has failed to follow MPEP guidelines for making a lack of unity of invention requirement between restricted Groups. MPEP §1893.03(d) states:

“When making a lack of unity of invention requirement, the Examiner must (1) list different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.”

The Examiner has not explained why each group lacks unity with each other group and has not specifically described the unique special technical features in each group to justify the conclusion of a lack of unity of invention. Accordingly, Applicants respectfully submit that the present Restriction Requirement is improper, and that the Restriction Requirement be withdrawn.

Moreover, the MPEP in §803 states as follows:

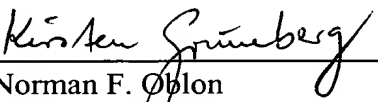
“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

Applicants respectfully submit that the above-identified application is now in  
condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
Norman F. Oblon  
Attorney of Record  
Registration No.: 24,618

Kirsten A. Grueneberg, Ph.D.  
Registration No.: 47,297



**22850**

PHONE: (703) 413-3000  
FAX: (703) 413-2220  
NFO:KAG:ekd  
I:\user\KGRUN\28390072.rrq.wpd